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EXAMINER

RYAN, PATRICK A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/675,468	Applicant(s) KARAOGUZ ET AL.	
	Examiner PATRICK A. RYAN	Art Unit 2427	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is made in response to Preliminary Amendment and Request for Continued Examination Under 37 CFR 1.114 ("Reply"), filed March 16, 2009.

Applicant has amended Claims 1, 11, and 21; added Claims 32-40; and no claims have been canceled. As amended, Claims 1-40 are presented for examination.

2. In Office Action of January 5, 2009 ("Office Action"):

Claims 1-8, 11-18, 21-28, and 31 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boston et al (US Patent 7,212,730), hereinafter "Boston", in view of Tomsen (US Patent 7,103,908 B2).

Claims 9, 10, 19, 20, 29, and 30 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Boston and Tomsen as applied to Claim 1 and in further view of Oh (US PGPUB 2002/0161713 A1).

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 16, 2009 has been entered.

Response to Arguments

4. Applicant's arguments, see Reply Pages 19-20, with respect to Claims 1, 11, and 21 have been fully considered but they are not persuasive.

5. Applicant presents that the combination of Boston and Tomsen does not disclose or suggest the Claim 1, 11, and 21 limitation of “automatically displaying, without user interaction and prior to viewing at least a portion of said received advertisement, a notification of said received advertisement on said television” because Tomsen “discloses that the advertisement content has already been received and presented to the user, at the time when the notification is displayed” (Reply Pages 15-17 and Abstract of Tomsen). The Examiner respectfully disagrees.

The Examiner has previously presented that Indicator 404 and Prompt 502 of Tomsen have been used to address Applicants limitation of automatically displaying a notification of a received advertisement on a television screen (Office Action Page 5 and Figs. 4 and 5 of Tomsen). In addition, Tomsen's teachings of triggers, resources, or announcements within the content stream delivered from the broadcast source can be used to provide the notification, without user interaction, on the television screen (as Tomsen discloses in Col. 5 Lines 1-19).

The Examiner additionally submits that Tomsen teaches automatically displaying the notification prior to the user viewing the advertisement at least a portion of the advertisement. In particular, Tomsen demonstrates the presentation of a first portion of the advertisement (Television Commercial 404 in Fig. 4 and 5), where the user is

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prompted whether or not to watch the whole advertisement at that instant in time or defer watching the whole advertisement to a later time (as described in Col. 6 Line 63—Col. 7 Line 29). It is the Examiner's position that when the user elects to defer the presentation of the advertisement, the remaining portion of the advertisement is not presented to the user during the display of the advertisement until the user revisits the advertisement (as shown in Fig. 9 and described in Col. 9 Lines 10-46; with further reference to Step 1016 of Fig. 10). Therefore, when the user elects to defer the presentation of the advertisement in response to the notification, the notification (Indicator 404 or Prompt 502) is presented to the user prior to the remaining portion of the advertisement (i.e. Fig. 6) being displayed.

The Examiner therefore submits that the combination of Boston and Tomsen does in fact teach the Claim 1, 11, and 21 limitation of "automatically displaying... prior to viewing at least a portion of said received advertisement, a notification of said received advertisement on said television"

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-8, 11-18, 21-28, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boston et al (US Patent 7,212,730), hereinafter "Boston", in view of Tomsen (US Patent 7,103,908 B2).

8. In reference to claims 1 and 21, Boston teaches a method (see Figure 8 described in Col. 8 Lines 52-53) of and processor (see processor 3000 of Figure 30 described in Col. 25 Lines 10-15) for providing an advertisement in a communication channel, the method and processor operation comprising:

receiving the advertisement for display on a television within a home (step 965 of Figure 9 described in Col. 10 Lines 2-4);

displaying media corresponding to at least a portion of said scheduled advertisement on said television based on said scheduling (step 935 of Figure 9 described in Col. 9 Lines 55-58; with further reference to steps 1010 and 1015 of Fig. 10 Col. 10 Lines 22-31),

Boston teaches scheduling, based on times designated by content provider, an advertisement for viewing at the user's location (step 945 of Figure 9 described in Col 9 Lines 58-61), but does not teach automatically display, without user interaction and prior to viewing at least a portion of said received advertisement, a notification of the advertisement on said television, and scheduling, based on input from a user provided after said display of said notification.

In a similar field of invention, Tomsen teaches a method and system for allowing a user to save content presented in an interactive television environment and allowing a user to defer viewing of a television advertisement to a later time (Abstract). In

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particular, Tomsen discloses including triggers, resources, or announcements within the content stream delivered from the broadcast source, as disclosed in Col. 5 Lines 1-19. In addition, Tomsen teaches presenting an announcement automatically to a user (i.e. Indicator 404 or Prompt 502) and without the user's interaction by way of the triggers contained in the broadcast stream during the presentation of Television Commercial 402, as shown in Figs. 4 and 5; with further reference to Col. 6 Line 25—Col. 7 Line 29 and Steps 1008-1010 of Fig. 10. Since the broadcaster designates and delivers the trigger information regarding the announcement, it is the Examiner's position that the user has no influence or control on when the announcement is initially presented. Tomsen further discusses that based on the users interaction after the announcement is presented, a user can select to defer viewing of the advertisement by saving the information to Set-top Box 152 (i.e. scheduling or planning to view at a later time) so that a user can refer to it at a later time or resume the transaction (as disclosed in Col. 7 Lines 8-29; with further reference to Col. 8 Lines 10-56). In addition, when the user elects to defer the presentation of the advertisement in response to the notification, the notification (Indicator 404 or Prompt 502) is presented to the user prior to the remaining portion of the advertisement (i.e. Fig. 6) being displayed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaches of Boston regarding the presentation of the availability of advertisement content with Tomsen's teaching of prompting a user to defer the consumption of a television commercial. One of ordinary skill would be motivated to make this combination in order to provide the user with greater flexibility over the

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consumption of program content that interests them, which can increase the likelihood that the commercial will be consumed by the user (as Tomsen discusses in Col. 1 Line 51—Col. 2 Line 5).

9. In reference to claims 2 and 22, the combination of Boston and Tomsen teach a method of and processor for presenting data representative of said received advertisement (Figure 12 described by Boston in Col. 12 Lines 18-20) in an available slot in a channel guide (detailed edit schedule 1200 of Figure 12 described by Boston in Col.12 Lines 4-12).

10. In reference to claims 3 and 23, the combination of Boston and Tomsen teach a method of and processor for displaying data representative of said received advertisement where the advertisement is one or more of graphical data, textural data, audio data and video data (disclosed by Boston in Col. 2 Lines 56-65).

11. In reference to claims 4 and 24, the combination of Boston and Tomsen teach a method of and processor for establishing a user profile (Figures 3 and 4 described by Boston in Col. 5 Lines 35-67 and Col. 6 Lines 1-54) indicating at least a particular type of advertisement that is to be received (detailed edit schedules 610 described by Boston in Col. 6 Lines 60-63).

12. In reference to claims 5 and 25, the combination of Boston and Tomsen teach a method of and processor for determining whether data representative of said particular type of advertisement is within said established profile (step 840 of Figure 8 described by Boston in Col.9 Lines 4-10); and if said data representative of said particular type of

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advertisement is within said established profile, receiving said particular type of advertisement (step 860 of Figure 8 described by Boston in Col.9 Lines 10-12).

13. In reference to claims 6 and 26, the combination of Boston and Tomsen teach a method of and processor for identifying a gap that exists in a schedule in a channel guide displayed on said television (step 835 of Figure 8 described by Boston in Col 8 Lines 52-67 and Col. 9 Lines 1-16; with further reference to Edit Schedule 815 implemented in Step 810 and depicted in Figure 12 described in Col. 12 Lines 4-32).

14. In reference to claims 7 and 27, the combination of Boston and Tomsen teach a method of and processor for scheduling at least one advertisement for display at a time corresponding to said identified gap (decision 1040 of Figure 10 described by Boston in Col. 10 Lines 44-48).

15. In reference to Claims 8, 18, and 28, the combination of Boston and Tomsen teaches a method for granting permission to schedule at least one advertisement for display within said identified gap (Boston teaches the identification of gaps in the program schedule by way of Edit Schedule 815 implemented in Step 810 and depicted in Figure 12 described in Col. 12 Lines 4-32; with further reference to steps 1010 and 1015 of Fig. 10 Col. 10 Lines 22-31. In addition, Tomsen teaches a method of granting permission to schedule a commercial presented for playback at a later time, as described in Col. 7 Lines 8-29; with further reference to Col. 8 Lines 10-56).

16. In reference to claims 11, 12, 13, 14, 15, 16, and 17, the combination of Boston and Tomsen teach a machine-readable storage having stored thereon, a computer

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program having at least one code section for providing an advertisement in a communication network (disclosed by Boston in Col. 25 Lines 16-25), the at least one code section being executable by a machine (disclosed by Boston in Col. 25 Lines 25-27) for causing the machine to perform the method of claims 1 through 10, as addressed above.

17. In reference to claim 21, the combination of Boston and Tomsen teach a system for providing an advertisement in a communication network (system diagram shown in Figure 6 as described by Boston in Col. 6 Lines 55-63) for causing the machine to perform the method of claims 1 through 10, as addressed above.

18. In reference to claim 31, the combination of Boston and Tomsen teach a processor that is a media management system processor (processor 3000 of Figure 30 disclosed by Boston in Col 24 Lines 1-5).

19. Claims 9, 10, 19, 20, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Boston and Tomsen as applied to Claim 1 and in further view of Oh (US PG PUB 2002/0161713 A1).

20. In reference Claims 9, 10, 19, 20, 29, and 30 the combination of Boston and Tomsen do not teach a method for offering a reward for scheduling the advertisement for display within a personal advertisement channel. In addition, Boston and Tomsen

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do not teach a method where said reward comprises at least one of free programming and reduced programming cost. However, Oh teaches a reward method of providing advertisement content to a user in which multimedia content prices are discounted in an incremental fashion dependent upon when the user elects to view the given advertisement (as disclosed in Paragraph 0054). In addition, if the user elects to view the advertisement while the multimedia content is being played, the system provides the said multimedia content for free (as disclosed in Paragraph 0054 Lines 8-12).

In view of Oh's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of advertisement insertion and scheduling disclosed by Boston and Tomsen to incorporate a method discounting programming content based on the event of a user scheduling an advertisement to be viewed. It would be advantageous to have an advertising system that rewarded the user for scheduling an advertisement for viewing because the user would be more likely to view additional program content and related advertisements in exchange for free or reduced cost programming (as Oh describes in Paragraph 0011).

21. Claims 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Boston and Tomsen as applied to Claim 1 and in further view of Wood et al. (US PG PUB 2002/0054752 A1), hereinafter "Wood".

22. In reference to claim 32, the combination of Boston and Tomsen teaches the method according to claim 1, Tomsen teaches allowing a user to defer the viewing of an

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advertisement to a later time, however the combination does not explicitly disclose scheduling for display one or more personal media channels on said television.

In a similar field of invention, Wood teaches a method and apparatus for organizing locally stored television recordings into personal channels (Abstract). In particular, Wood demonstrates in Figure 10 that a user can create a personal channel within a personal channel guide for displaying the recorded television shows according to a schedule (as described in Paragraphs [0061-0064]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the scheduling and displaying of locally stored advertisements, as taught by the combination of Boston and Tomsen, to include a personal channel interface for organizing locally stored media content, as taught by Wood, in order to provide the user with a means to organize and consolidate the locally stored content (as Wood suggests in Paragraphs [0008-0010]).

23. In reference to claim 33, the combination of Boston, Tomsen, and Wood teaches the method according to claim 32, comprising authoring said one or more personal media channels by friends and family members of said user (Wood teaches that multiple user, for examiner within a household, can provide criteria information regarding the personal channels, as disclosed in Paragraph [0055]).

24. In reference to claim 34, the combination of Boston, Tomsen, and Wood teaches the method according to claim 32, comprising scheduling said received advertisement as an advertisement channel in a personal media channel guide (Boston teaches scheduling advertisements for a channel using “edit schedules for commercials”, as disclosed in Col. 32-40. In addition, Wood teaches the organization of locally stored

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media into personal channels, as shown in Fig. 10 and described in Paragraphs [0061-0064]).

25. The limitations of claim 35 have been addressed with claims 32 and 11.

26. The limitations of claim 36 have been addressed with claims 33 and 11.

27. The limitations of claim 37 have been addressed with claims 34 and 11.

28. The limitations of claim 38 have been addressed with claims 32 and 21.

29. The limitations of claim 39 have been addressed with claims 33 and 21.

30. The limitations of claim 40 have been addressed with claims 34 and 21.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

32. Novak, United States Patent Application Publication (2002/0104099 A1), teaches a method and system for creating and scheduling a personal television channel (Abstract).

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK A. RYAN whose telephone number is (571)270-5086. The examiner can normally be reached on Mon to Thur, 8:00am - 5:00pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. A. R./
Examiner, Art Unit 2427
Monday, May 11, 2009

/Scott Beliveau/
Supervisory Patent Examiner, Art Unit 2427